

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application of:	) Date: January 16, 2008
Mark A. Bresnan, et al.	) Attorney Docket No.: F-773
Serial No.: 10/737,244	) Customer No.: 00919
Filed: December 16, 2003	) Group Art Unit: 3628
Confirmation No.: 6361	) Examiner: Rutao Wu

Title:     DOCUMENT CONSOLIDATOR AND DISTRIBUTOR FOR  
          EFFICIENT MESSAGE PRODUCTION

**PRE-APPEAL BRIEF CONFERENCE REQUEST**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants request this pre-appeal review to consider the Examiner's rejections of claims 2-16, 18-37, 39-54 and 56-75 in a Final Office Action dated October 16, 2007. A Notice of Appeal is filed herewith. For convenience, the current claims are listed on Appendix A.

**I. STATUS OF THE CLAIMS**

Claims 2–16, 18–37, 39–54, and 56–75 are pending in this application. For convenience, these claims are attached hereto as an appendix. The Examiner refused to enter an amendment-after-final dated December 19, 2007. Since that amendment merely simplified issues for appeal, it is submitted that refusal of entry was a mistake that should be corrected to expedite this review and the appeal process.

**II. Mistaken Refusal to Enter the Amendment-After-Final**

In the December 19 Amendment-After-Final, Applicants simplified the issues for a potential appeal by making independent claims 3, 12, 41, 50 more narrow by fully incorporating features of particular dependent claims. In particular, claim 3 was amended to include all features of claim 7 and intervening claim 6. Claim 12 was amended to include all the features of claim 18. Claim 41 was amended to include all features of dependent claim 45, and intervening claim 44. Claim 50 was amended to include features previously recited in claim 56. The subject matter of the dependent claims was rejected under §103 obviousness, while the unamended independent claims were rejected under §102 anticipation.

By refusing to enter those claim amendments, it will now be necessary to address both the §102 for the broader claims and §103 issues for the narrower claims in the appeal. The scope of the proposed amended independent claims is the same as the prior dependent claims, and the amendments clearly simplify issues for appeal, so entry of those amendments would be appropriate. By making this determination, the review panel can also eliminate the need for potential petitions on this issue.

Applicants also note that the Examiner refused to enter amendments that were solely for clarification and that were directed to alleged deficiencies under §112, and that those amendments are also clearly in the interest of eliminating issues for appeal.

### **III. Rejections Under 35 U.S.C. § 102(b)**

For purposes of this pre-appeal brief conference request, Applicants will focus on the features of the dependent claims which Applicants attempted to incorporate into the independent claims in the Amendment-After-Final. Those claims fall under the obviousness rejections discussed below. If the conference panel finds the subject matter of those dependent claims to be allowable, then Applicant would be willing to again incorporate those allowable features into all of the independent claims.

### **IV Rejections Under 35 U.S.C. § 103(a)**

#### **Rejections based on Schumacher alone.**

Dependent claims 7, 18, 45, and 56 stand rejected under §103 obviousness in view of U.S. Patent 5,058,030 to Schumacher ("Schumacher") .

#### ***Claims 7 and 45***

These claims recite marketing rules that are used to determine whether messages with particular marketing content may, or may not, be combined. The Examiner, has acknowledged that Schumacher does not disclose these features, but asserts that known privacy considerations would have made those features obvious. Even assuming that the unsupported motivation of "privacy" existed, there is no nexus between the alleged privacy considerations and the feature recited in the claims. The claims are directed to whether particular marketing content can be consolidated. There is no privacy concern that is being addressed by these features. Accordingly, the Examiner has not identified any prior art, or any relevant basis, for finding that these features were known, or obvious.

In particular in Schumacher, the messages that are being combined are going to the same person. See, e.g., col. 3, lines 8-18, col. 10, lines 15-64. Thus, there would never be any concern about privacy that would justify the Examiner's assertions that the relevant features would be obvious. Also, there is no basis for a "privacy" fear that the creator of the marketing content would know anything about the document on which the message was being printed. It is clear, for example, that a message promoting 1-800-FLOWERS on a persons credit card statement, does not mean that the flower company has access to the credit card data. Further, the argument fails further because the claim elements do nothing to eliminate these fabricated concerns of privacy, and would

therefore not be an obvious solution to that alleged problem. It is only through improper hindsight that the Examiner has found obviousness, and no reasonable basis has been provided for the existence of the the alleged "privacy" prior art or for combining it with the Schumacher reference. The Examiner's chain of reasoning is speculative and is unsupported throughout.

#### ***Claims 18 and 56***

These claims recite a sender rule that determines whether messages with particular business content may, or may not, be combined. The Examiner has acknowledged that Schumacher does not disclose these features, but asserts that known privacy considerations would have made those features obvious. Even assuming that the unsupported motivation of "privacy" existed, there is no nexus between the alleged privacy considerations and the feature recited in the claims. The claims are directed to whether particular business content can be consolidated. There is no privacy concern that is being addressed by these features. Accordingly, the Examiner has not identified any prior art, or any relevant basis, for finding that these features were known, or obvious. The Examiner has also failed to identify how any alleged privacy violation would occur. Merely including business content from two sources does not mean that existence of a privacy violation.

In particular in Schumacher, the messages that are being combined are going to the same person. See, e.g., col. 3, lines 8-18, col. 10, lines 15-64. Thus, there would never be any concern about privacy that would justify the Examiner's assertions that the relevant features would be obvious. Nor is there any explanation as to why the particular recited combination would be arrived at based on the alleged privacy concern. It is only through improper hindsight that the Examiner has found obviousness, and no reasonable basis has been provided for combining the alleged "privacy" prior art with the Schumacher reference.

For at least these reasons, it is submitted that the obviousness rejections of these claims based on Schumacher alone should be withdrawn.

V. CONCLUSION

For these reasons, it is submitted that at least claims 7, 18, 45 and 56 should be found allowable, and that the refusal to add the subject matter of those claims to the independent claims was inappropriate. Please contact the undersigned representative if there are any questions regarding this application.

Respectfully submitted,

/Michael J. Cummings/  
Michael J. Cummings  
Reg. No. 46,650  
Attorney of Record  
Telephone (203) 924-3934

PITNEY BOWES INC.  
Intellectual Property and  
Technology Law Department  
35 Waterview Drive  
P.O. Box 3000  
Shelton, CT 06484-8000

## **APPENDIX A**

### **Listing of Claims:**

1. (Cancelled)

2. The message processing system of claim 3 wherein the distributor module is programmed to format the consolidated message packages in accordance with the determined optimal routing.

3. A message processing system for preparing a plurality of messages to be distributed to recipients, the system comprising:

a consolidator module receiving data corresponding to the plurality of messages, the consolidator module programmed to consolidate multiple of the plurality of messages into a single message package, the consolidator module consolidating the messages based on first criteria;

a distributor module coupled to the consolidator module and receiving a data stream containing consolidated message packages, the distributor module programmed to determine optimal routing for production of message packages based on second criteria;

wherein the recipients are customers and the consolidator module and the distributor are coupled to a customer relationship management system, the customer relationship management system determining at least some of the first and second criteria.

4. The message processing system of claim 3 wherein the customer relationship management system determines a template for message packages and the template is transmitted to the consolidator module for forming the message packages.
5. The message processing system of claim 4 wherein the template includes marketing content developed by marketing tools in the customer relationship management system.
6. The message processing system of claim 3 wherein the first and second criteria include marketing business rules determined by the customer relationship management system.
7. The message processing system of claim 6 wherein the marketing rules include a rule that messages including particular marketing content may, or may not, be consolidated.
8. The message processing system of claim 3 wherein the first and/or second criteria include customer preferences.
9. The message processing system of claim 8 wherein the first criteria includes a customer preference on whether or not consolidation is desired.
10. The message processing system of claim 8 wherein the first criteria includes a customer preference on whether or not householding is desired.

11. The message processing system of claim 8 wherein the second criteria includes a customer preference of physical mail or electronic delivery.

12. A message processing system for preparing a plurality of messages to be distributed to recipients, the system comprising:

a consolidator module receiving data corresponding to the plurality of messages, the consolidator module programmed to consolidate multiple of the plurality of messages into a single message package, the consolidator module consolidating the messages based on first criteria;

a distributor module coupled to the consolidator module and receiving a data stream containing consolidated message packages, the distributor module programmed to determine optimal routing for production of message packages based on second criteria;

wherein the consolidator module and the distributor are coupled to a statement applications processing module, the statement applications processing module determining at least some of the first and second criteria; and

wherein the first and second criteria include sender rules received from the statement applications processing module.

13. The message processing system of claim 12 wherein the statement applications processing module provides message business data to the consolidator module for forming the message packages.



14. The message processing system of claim 12 wherein the statement applications processing module receives data from an automated data factory having a plurality of mail production sites.

15. The message processing system of claim 14 wherein the distributor module receives postal delivery metrics, and wherein the distributor module calculates transit times for message delivery from the plurality of mail production sites.

16. The message processing system of claim 14 wherein the second criteria includes quality requirements and wherein the distributor module receives service and quality metrics corresponding to the plurality of mail production sites, and wherein the distributor module routes message packages based on sites meeting the quality requirements.

17. (Cancelled)

18. The message processing system of claim 12 wherein the first criteria include a sender rule that messages including particular business content may, or may not, be consolidated.

19. The message processing system of claim 12 wherein the first criteria include a sender rule that messages including particular business content may, or may not, be householded.

20. The message processing system of claim 12 wherein the second criteria include a sender rule that messages including particular business content may, or may not, be electronically delivered.

21. The message processing system of claim 12 wherein the sender rules include a requirement to minimize time for delivery of messages to recipients, and whereby the consolidator module and distributor module form and route message packages in order to minimize time for delivery.

22. The message processing system of claim 12 wherein the sender rules include a requirement to maximize throughput of message packages, and whereby the consolidator module and distributor module form and route message packages in order to maximize throughput.

23. The message processing system of claim 12 wherein the sender rules include a requirement to minimize mail production costs, and whereby the consolidator module and distributor module form and route message packages in order to minimize mail production costs.

24. The message processing system of claim 12 wherein the consolidator selects messages for consolidation from the plurality of messages based on the messages including a same delivery address.

25. The message processing system of claim 24 wherein the consolidator selects messages for consolidation based on messages having due dates proximal in time.

26. The message processing system of claim 25 wherein due dates of messages selected for consolidation are adjusted by the consolidator module to match.

27. The message processing system of claim 25 wherein the consolidator module determines whether a customer preference authorizes consolidation for a particular message, and whereby consolidation is disallowed by the consolidator module if there is no authorization.

28. The message processing system of claim 27 wherein, if the customer preference does not authorize consolidation, the consolidator generates content to be included in the message that describes benefits of consolidation.

29. The message processing system of claim 25 wherein the consolidator module determines whether a customer preference authorizes householding for a particular message, and whereby householding is disallowed by the consolidator module if there is no authorization.

30. The message processing system of claim 29 wherein, if the customer preference does not authorize householding, the consolidator generates content to be included in the message that describes benefits of householding.

31. The message processing system of claim 12 wherein the distributor module determines optimal site routing based on real time site production data.

32. The message processing system of claim 31 wherein the distributor module determines whether a site or a machine at a site is non-operational, and wherein the second criteria include a failover site or channel designation, and whereby the failover site or channel designation is used for optimal routing instead of the non-operational site or machine.

33. The message processing system of claim 31 wherein the distributor module determines optimal site routing based on real time costs of site operation.

34. A message processing system for preparing a plurality of messages to be distributed to recipients, the system comprising:

a consolidator module receiving data corresponding to the plurality of messages, the consolidator module programmed to consolidate multiple of the plurality of messages into a single message package, the consolidator module consolidating the messages based on first criteria;

a distributor module coupled to the consolidator module and receiving a data stream containing consolidated message packages, the distributor module programmed to determine optimal routing for production of message packages based on second criteria;

wherein the distributor module determines optimal site routing based on historical site production data.

35. The message processing system of claim 34 wherein the distributor module, in determining optimal routing, determines whether quality improvements can be made over past performance.

36. The message processing system of claim 34 wherein the distributor module determines optimal site routing based on historical costs of site operation.

37. The message processing system of claim 34 wherein the distributor module determines optimal site routing based on postal service delivery time data for respective sites.

38. (Cancelled).

39. The method of claim 41 wherein the step of determining optimal routing includes designating electronic presentment of the message packages and the step of transmitting includes electronic presentment of the message packages.

40. The method of claim 41 further comprising the step of formatting the consolidated message packages in accordance with the determined optimal routing.

41. A method for processing and preparing a plurality of messages to be distributed to recipients, the method comprising:

receiving data corresponding to the plurality of messages;

consolidating multiple of the plurality of messages into single message packages, said consolidating of the messages into consolidated message packages based on first criteria;

determining optimal routing for production of message packages based on second criteria;

transmitting the message packages to one or more of a plurality of message production sites based on the optimal routing; and

determining at least some of the first and second criteria through a customer relationship management system.

42. The method of claim 41 further comprising the step of determining a template for message packages with the customer relationship management system.

43. The method of claim 42 wherein the step of determining the template comprises including marketing content developed by marketing tools in the customer relationship management system.

44. The method of claim 41 wherein the step of determining the first and second criteria includes marketing business rules determined by the customer relationship management system.

45. The method of claim 44 including a step of preventing messages from being consolidated based on the marketing rules that include a rule that messages including particular marketing content may, or may not, be consolidated.

46. The method of claim 41 further including gathering customer preference data and including it in the first and/or second criteria.

47. The method of claim 46 wherein the step of consolidating is controlled based on the first criteria which includes a customer preference on whether or not consolidation is desired.

48. The method of claim 46 wherein the step of consolidating is controlled based on the first criteria which includes a customer preference on whether or not householding is desired.

49. The method of claim 46 wherein the step of determining optimal routing is based on the second criteria which includes a customer preference of physical mail or electronic delivery.

50. A method for processing and preparing a plurality of messages to be distributed to recipients, the method comprising:

receiving data corresponding to the plurality of messages;

consolidating multiple of the plurality of messages into single message packages, said consolidating of the messages into consolidated message packages based on first criteria;

determining optimal routing for production of message packages based on second criteria;

transmitting the message packages to one or more of a plurality of message production sites based on the optimal routing; and

determining at least some of the first and second criteria with a statement applications processing module;

wherein the step of determining at least some of the first and second criteria includes incorporating sender rules received from the statement applications processing module.

51. The method of claim 50 further including the step of providing message business data from the statement applications processing module for forming the message packages.

52. The method of claim 50 further including the step of receiving data from an automated data factory controlling the plurality of mail production sites, and using said automated data factory data for determining said optimal routing.

53. The method of claim 52 further including receiving postal delivery metrics, and the step of determining optimal routing includes calculating transit times for message delivery from the plurality of mail production sites.

54. The method of claim 52 further including the steps of  
receiving service and quality metrics corresponding to the plurality of mail production sites;  
including quality requirements in the second criteria; and  
determining the optimal routing of message packages based on sites meeting the quality requirements.

55. (Cancelled).



56. The method of claim 50 wherein the step of consolidating is controlled by the first criteria which includes a sender rule that messages including particular business content may, or may not, be consolidated.

57. The method of claim 50 wherein the step of consolidating is controlled by the first criteria which includes a sender rule that messages including particular business content may, or may not, be householded.

58. The method of claim 50 wherein the step of determining optimal routing is based on a sender rule that messages including particular business content may, or may not, be electronically delivered.

59. The method of claim 50 wherein the sender rules include a requirement to minimize time for delivery of messages to recipients, and the steps of consolidating and determining optimal routing are controlled to form and route message packages in order to minimize time for delivery.

60. The method of claim 50 wherein the sender rules include a requirement to maximize throughput of message packages, and the steps of consolidating and determining optimal routing are controlled to form and route message packages in order to maximize throughput.

61. The method of claim 50 wherein the sender rules include a requirement to minimize mail production costs, and wherein the steps of consolidating and determining

optimal routing are controlled to form and route message packages in order to minimize mail production costs.

62. The method of claim 50 wherein the step of consolidating includes selecting messages for consolidation from the plurality of messages based on the messages having a same delivery address.

63. The method of claim 62 wherein the step of consolidating includes selecting messages for consolidation based on messages having due dates proximal in time.

64. The method of claim 63 wherein the step of consolidating includes adjusting the due dates of messages selected for consolidation so that consolidated messages have the same due dates.

65. The method of claim 63 wherein the step of consolidating includes determining whether a customer preference authorizes consolidating for a particular message, and whereby consolidating is disallowed if there is no authorization.

66. The method of claim 65 wherein, if the customer preference does not authorize consolidation, further including a step of generating content to be included in the message describing benefits of consolidation.

67. The method of claim 63 wherein the step of consolidating includes determining whether a customer preference authorizes householding for a particular message, and whereby householding is disallowed if there is no authorization.

68. The method of claim 67 wherein, if the customer preference does not authorize householding, further including a step of generating content to be included in the message describing benefits of householding.

69. The method of claim 50 wherein the step of determining optimal routing is based on real time site production data received from the plurality of message production sites.

70. The method of claim 69 wherein the step of determining optimal routing includes identifying whether a site or a machine at a site is non-operational, and wherein the second criteria include a failover site or channel designation, and whereby the failover site or channel designation is used for optimal routing instead of the non-operational site or machine.

71. The method of claim 69 wherein step of determining optimal routing is based on real time costs of site operation.

72. A method for processing and preparing a plurality of messages to be distributed to recipients, the method comprising:

- receiving data corresponding to the plurality of messages;

- consolidating multiple of the plurality of messages into single message packages, said consolidating of the messages into consolidated message packages based on first criteria;

- determining optimal routing for production of message packages based on second criteria;

transmitting the message packages to one or more of a plurality of message production sites based on the optimal routing;

wherein the step of determining optimal site routing is based on historical site production data.

73. The method of claim 72 the step of determining optimal routing includes determining whether quality improvements can be made over past site performance.

74. The method of claim 72 wherein the step of determining optimal site routing is based on historical costs of site operation.

75. The method of claim 72 wherein the step of determining optimal site routing is based on postal service delivery time data for respective sites.